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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92046037
Party	Defendant NOVATECH SA
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Attachments	1811-71 Reply to Response to Summary Judgment.pdf (5 pages)(260442 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Registration No. 3,093,389
Registered on: May 16, 2006

BRYAN CORPORATION,	§	
	§	
Petitioner,	§	
	§	
v.	§	Cancellation No. 92046037
	§	
NOVATECH SA,	§	
	§	
Registrant.	§	

**REGISTRANT'S REPLY IN SUPPORT OF
MOTION FOR SUMMARY JUDGMENT**

NOVATECH SA ("Registrant") has moved under Rule 2.127 of the Trademark Rules of Practice and Federal Rule of Civil Procedure 56 for summary judgment and dismissal of BRYAN CORPORATION's ("Petitioner") Petition to Cancel Registrant's Reg. No. 3,093,389 for the mark "STERITALC" on November 30, 2007. Petitioner filed its Response in Opposition to Summary Judgment on October 14, 2008. Registrant now files this Reply in Support of its Motion for Summary Judgment pursuant to TBMP § 502.02(b).

FACTS

1. After receiving the Board's Order on Petitioner's Rule 56(f) Motion for discovery on August 29, 2008, Registrant timely complied with the Board's Order on September 15, 2008 by serving its Supplemental Answers to Petitioner's Second Set of Interrogatories to Petitioner. *See* [Ex. F to Response to Summary Judgment]. In accordance with the Board's Order, Registrant submitted an unequivocal answer to the Interrogatory No. 5 of Petitioner's Second Set of Interrogatories. *See* [August 29, 2008 Order].

2. While Petitioner timely filed its Response in Opposition to Novatech SA's Motion for Summary Judgment on October 14, 2008, the required response was made while concurrently filing a Motion for Sanctions. Importantly, the Motion for Sanctions was the only possible motion that the Board's Order allowed Petitioner to file without initiating a telephone conference with Registrant and the Board to discuss its intentions. *See id.*

3. Since Petitioner's Motion for Sanctions is discussed throughout Petitioner's Response to Motion for Summary Judgment, Registrant hereby incorporates its Response to Petitioner's Motion for Sanctions by reference to the extent any of the arguments contained therein are applicable to any of the issues surrounding Registrant's Motion for Summary Judgment. *See* [Registrant's Response to Motion for Sanctions].

DISCUSSION

4. In Petitioner's Response to Summary Judgment, Registrant briefly discusses the discovery issues between the parties that led to the Board's Order of October 14, 2008. *See* [Response to Summary Judgment]. As discussed in more detail in Registrant's Response to Motion for Sanctions, Registrant fails to see any significance of issues previously adjudicated by the Board and completely and timely complied with by registrant upon service of its Second Supplemental Answers to Interrogatories on September 15, 2008. *See* [Ex. F to Petitioner's Motion for Sanctions]. The arguments brought up by Petitioner in its Response to Registrant's Motion for Summary Judgment and the corresponding Motion for Sanctions are completely unfounded for since it is clear that Petitioner has waived its right to object to any alleged deficiencies in Registrant's Verification, has failed to make a good faith effort to contact Registrant regarding the alleged discovery issue, and has not met its burden of proving that a deficiency exists in its Verification. *See id.*; *see* TBMP

§707.04 (explaining various instances when a party waives the right to object to procedural deficiencies if the ground for objection is one that could have been cured if raised properly); *see* TBMP §523.02; *see also* [Registrant's Response to Motion for Sanctions] (for a more detailed discussion of Petitioner's beliefs). Furthermore, the alleged deficiency has not prevented Petitioner from filing a Response to Registrant's Motion for Summary Judgment. Indeed, the Board invited Petitioner to contact the Examiner if it had any intentions other than a Response to Summary Judgment in mind. *See* [August 29, 2008 Order].

5. Contrary to Petitioner's statement on pages 4-5 of its Response for Summary Judgment, Registrant's position has consistently been that it is impossible for Petitioner to have a trademark interest in the phrase "STERILE TALC POWDER" because it is a generic mark. *See* [Answer to Pet. for Cancellation, ¶ 14 and Second Affirmative Defense, ¶ 22]. Therefore, the alleged "use" of the phrase "STERILE TALC POWDER" by Petitioner does help it meet the "real interest" required to establish standing in a Cancellation proceeding. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999). Quite simply, if Petitioner's mark is generic, any party that manufactures talc powder is allowed to use the phrase "STERILE TALC POWDER" to identify its goods, including Registrant. Furthermore, any of the alleged problems, or alleged damages, claimed by Petitioner in the Affidavits attached to its response cannot be said to arise because Registrant's "STERITALC" mark exists on the trademark register. *See Chemical New York Corp. v. Conmar Form Systems, Inc.*, 1 USPQ2d 1139, 1142 (TTAB 1986). To the contrary, any alleged problems, threats, or damages were self-created when Petitioner chose to use the generic name of the product it manufactures to identify such products. *See* [Exhibit 16, Emails of Petitioner] (attached hereto as rebuttal evidence and submitted to the Board as Confidential) (proving that

employees of Petitioner, including Ms. Jane Campbell, knew that "STERILE TALC POWDER" was a non-proprietary name when it was chosen).

6. The decision in *Herbaceuticals, Inc. v. Xel Herbaceuticals, Inc.*, 86 USPQ2d 1572, 1575-76, does not apply in this proceeding. The Board specifically allowed standing in that case because "HCI included as an exhibit to its motion for summary judgment a certified copy of pleaded Registration No. 2585974 showing that the registration is in full force and effect and owned by HCI. Such copy is sufficient to show that there is no genuine issue of material fact that HCI has a real interest in the proceedings, i.e., a personal interest in the outcome of the proceeding, and a reasonable basis for a belief of damage." Petitioner has only claimed a common law right in the phrase "STERILE TALC POWDER."

7. Petitioner's products are clearly not unique, but only had orphan drug status in the United States for a period of time. *See* [Exhibit 13 to Summary Judgment Motion]. This status has expired, therefore, at this time any entity can use the generic phrase "sterile talc powder" to identify such goods. *See id.* Indeed, Registrant is allowed to use the generic term sterile talc powder, in addition to its registered mark, within the United States at this time.

8. It is clear that the *Rudolph Wild GMBH* case parallels the issues in this proceeding. *See* [Exhibit 15 to Summary Judgment Motion]. In addition, the case was decided procedurally on Applicant's Motion for Summary Judgment regarding standing. *See id.*

CONCLUSION

For the foregoing reasons, Registrant Motion for Summary Judgment should be granted, the Petition for Cancellation should be dismissed in all respects, and Petitioner's Motion for Sanctions

should be denied in due course. No genuine issue of material fact has been raised by Petitioner in this proceeding.

Respectfully submitted,

November 3, 2008
Date

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CERTIFICATE OF SERVICE

This is to certify that on this 3rd day of November 2008, a true and correct copy of the foregoing document is being sent by regular mail to the following attorney of record for the Petitioner:

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